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| APPLICATION NO.   | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|-------------|----------------------|---------------------|------------------|
| 10/078,026  | 02/15/2002  | Kenneth C. Gardeski  | P-10097.00          | 4934             |
| 27581   | 7590        | 04/05/2005           | EXAMINER            |                  |
| MEDTRONIC, INC.<br>710 MEDTRONIC PARKWAY NE<br>MS-LC340<br>MINNEAPOLIS, MN 55432-5604 |             |                      | BUI, VY Q           |                  |
|   |             |                      | ART UNIT            | PAPER NUMBER     |
|   |             |                      | 3731                |                  |

DATE MAILED: 04/05/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/078,026

Applicant(s)

GARDESKI ET AL.

Examiner

Vy Q. Bui

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 07 January 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-36 is/are pending in the application.
- 4a) Of the above claim(s) 26-32 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-25 and 33-36 is/are rejected.
- 7) ☒ Claim(s) 9 and 10 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>4/02; 3&amp;5&amp;12/03</u> . | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### *Election/Restrictions*

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-25 and 33-36, drawn to a slitting tool, classified in class 606, subclass 167.
- II. Claims 26-32, drawn to a method, classified in class 604, subclass 161.

The inventions are distinct, each from the other because of the following reasons:

Inventions I and II are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case the product as claimed can be practiced to cut open a sealed envelope.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

During a telephone conversation with the Applicants' Representative, Mr. Chapik, on 3/30/2005 a provisional election was made without traverse to prosecute the invention of a slitting tool, claims 1-25 and 33-36. Affirmation of this election must be made by applicant in replying to this Office action. Claims 26-32 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

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Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

### ***Claim Objections***

Claims 9-10 contain the trademark/trade names "Tecothane TT-1074A", "DOW Isoplast 301" and "DOW Pellethane 2363-75D". Where a trademark or trade name is used in a claim as a limitation to identify or describe a particular material or product, the claim does not comply with the requirements of 35 U.S.C. 112, second paragraph. See *Ex parte Simpson*, 218 USPQ 1020 (Bd. App. 1982). The claim scope is uncertain since the trademark or trade name cannot be used properly to identify any particular material or product. A trademark or trade name is used to identify a source of goods, and not the goods themselves. Thus, a trademark or trade name does not identify or describe the goods associated with the trademark or trade name. In the present case, the trademark/trade name is used to identify/describe polymeric materials and, accordingly, the identification/description is indefinite.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

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Claims 1 and 33 recites the limitation "the IMD" (line 4, claim 1; lines 3-4, claim 33) and "the tubular body" (line 6, claim 1 and line 5, claim 33). There is insufficient antecedent basis for these limitations in the body of claims.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

1. Claims 1-4, 6, 11, 13-15, 18-19, 22-24 and 33-36 are rejected under 35 U.S.C. 102(e) as being anticipated by Brenner-6,497,681.

As to claims 1-4, 6, 11, 13-15, 18-19, 22 and 33-36 Brenner-'681 (Fig. 1A-1B, 5-6, 11-13) discloses a slitting tool comprising a body member/body means having a surface 22A/22B to be gripped by a user, surfaces 22A/22B has recess/textured area 52A/52B (Fig. 2 and 1B) and a base portion extends to form ridges 402/projections 502/ridges 602 to define a textured surface or an over-mold areas or over-mold means as a portion of channel or channel means 34A/34B, stepped portion defined by a transition portion between surface 22A/22B and channel 34A/34B (Fig. 2), cutting member or cutting means 60A/60B, guard member or guard means positioned adjacent to cutting member 60A/60B, gripping member defined by a portion of surfaces 22A/22B and nose portion 36A/36B.

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As to claims 23-24, because surface 22A/22B are deformable, therefore, channel 34A/34B has varying depth to accommodate varying sizes of a tubular body such as a lead.

2. Claims 16 and 25 are rejected under 35 U.S.C. 102(e) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Brenner-6,497,681.

As to claims 16 and 25, Fig. 1A-1B, 11-13 show curved cutter 60A/60B defining angles less than 45° or 60°. Alternatively, it would have been obvious to one of ordinary skill in the art to make cutting angles less than 45/60 degrees as these are obvious choices of design.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 5, 7-10, 12, 17, 20-21 and 25 rejected under 35 U.S.C. 103(a) as being unpatentable over Brenner-6,497,681.

As to claims 5 and 20, Brenner-'681 discloses substantially all limitations as recited in the claims, except for a process of forming the over-mold area such as by plasma etching, chemical milling, ion bombardment. However, the manufacturing process to form the over-mold area are well known processes in the art and it would have been obvious to one of ordinary skill in the art at the time of the invention to form ridges 402/projections 502/ridges 602 by one of the processes as recited in the claims for the processes are well known. In addition, for a device

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claim, the manner in which a structural limitation is formed is not given much patentable weight as compared to a claim directed to a manufacturing method.

As to claims 7-10, Brenner-'681 discloses substantially all limitations as recited in the claims, except for a lower durometer polymer to form the over-mold area. It is well known to form an lower durometer polymer overmold on a higher durometer polymer base of a device so as to provide more friction and better grip for the device. It would have been obvious to one of ordinary skill in the art at the time of the invention to form a softer overmold area for the Brenner device to provide a better grip for the Brenner device.

As to claim 12, Brenner-'681 discloses substantially all limitations as recited in the claims, except for a gripping member as a ring. A ring structure to receive a finger of a user for facilitating holding and manipulation of a medical device is well known in the medical art. It would have been obvious to one of ordinary skill in the art at the time of the invention to form a ring shape well above the area of locking element 42 on surface 22A/22B of the device to receive a finger of a user so as to facilitate a holding/manipulation of the device.

As to claim 17, Brenner-'681 discloses substantially all limitations as recited in the claims, except for a sawtooth edge for the cutting edge of cutting member 60A/60B. However, a cutting sawtooth edge configuration is well known in the art and it would have been obvious to one of ordinary skill in the art at the time of the invention to make cutting edge of member 60A/60B a sawtooth edge as this configuration is well known for effective cutting.

As to claim 21, Brenner-'681 discloses substantially all limitations as recited in the claims, except for channel to accommodate a lead having a diameter of between 2 to 8 French. It would have been obvious to one of ordinary skill in the art at the time of the invention to provide the channel of Brenner device to accommodate a lead having a diameter of between 2

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to 8 French as recited in the claim as one desire so as a lead in this range can be used with the Brenner device.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Vy Q. Bui whose telephone number is 571-272-4692. The examiner can normally be reached on Monday-Tuesday and Thursday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Anhtuan T Nguyen can be reached on 571-272-4963. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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03/30/2005

Vy Q. Bui  
Primary Examiner  
Art Unit 3731